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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,360	08/31/2000	Ichiro Nakano	1046.1221/JDH	4207

21171 7590 07/27/2005

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EXAMINER
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NGUYEN, KEVIN M

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/653,360

Applicant(s)

NAKANO ET AL.

Examiner

Kevin M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14, 16, 18-20 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14, 16, 18-20 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/19/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27, 2005 has been entered. An action on the RCE follows:
2. This office action is made in response to applicant's amendment filed on April 28, 2005. Claims 10, 15, 17 and 21 are cancelled, claims 1, 5, 9, 16, 18, 19, 20 and 26 are amended, claim 27 is new, and claims 1-9, 11-14, 16, 18-20 and 22-27 are currently pending in the application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 5, 9, 11-13, 16, 18, 19, 20, 22-24, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Okamoto et al (newly cited, US 6,088,481).

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4. As to claims 1, 5, 18 and 19, Okamoto et al teach a handwritten character input device associated with a method and a storage medium readable, the handwritten character input device comprising:

- an operation screen unit (a tablet incorporating display and input combined 1, fig. 3) hereinafter the touch display tablet 1;

- a first control circuit (a front end processor 2, fig. 3);

- an operation mode selecting unit (a main control portion 3 selects at least two mode such as a handwriting erase portion 6 and a handwriting display portion 5, fig. 3);

- a first mode (an erase mode/the handwriting erase portion 6, fig. 3) is settable to provide a first function (an erase function, fig. 3) corresponding to the touch operation including "the handwriting erase portion 6 erases the handwriting display area" (a touch position without displaying a marker as claimed, fig. 3, col. 7, lines 15-16);

- a second mode (a writing mode/the handwriting display portion 5, fig. 3) is settable to provide a second function (a writing function, fig. 3) including a handwriting display area of a prescribed size (a touch position of a pen generates displaying the marker as claimed) allowing display of handwriting of in the area (col. 7, lines 3-6), if the device is in a character input and editing mode (if the touch operation is detected on the display screen tablet 1, col. 6, line 65), one person of ordinary skill in the art to understand that the writing mode is not effective (without executing) to the erasing mode, while said main control portion 3 has selected mode.

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5. As to claims 9, 16 and 20, Okamoto et al teach a handwritten character input device associated with a method and a storage medium readable, the handwritten character input device comprising:

- an operation screen unit (the touch display tablet 1, fig. 3);

- a first control circuit (a front end processor 2, fig. 3);

- an operation mode selecting unit (a main control portion 3 selects at least two mode such as a handwriting erase portion 6 and a handwriting display portion 5, fig. 3);

- a first mode (an erase mode/the handwriting erase portion 6, fig. 3) is settable to provide a first function (an erase function, fig. 3) corresponding to the touch operation including "the handwriting erase portion 6 erases the handwriting display area" (a touch position without displaying a marker as claimed, fig. 3, col. 7, lines 15-16);

- a second mode (a writing mode/the handwriting display portion 5, fig. 3) is settable to provide a second function (a writing function, fig. 3) including a handwriting display area of a prescribed size (display the marker as claimed) allowing display of handwriting of in the area (col. 7, lines 3-6), if the device is in a character input and editing mode (if the touch operation is detected on the display screen tablet 1, col. 6, line 65), at step S15 (fig. 28), it is determined whether or not there is any handwriting, when there is handwriting and the prescribed time has passed, that is, when no operation for the prescribed time after writing is detected, end of writing operation is determined (fig. 28, col. 15, lines 9-13), one person of ordinary skill in the art to understand that the writing mode is not effective (without executing) to the erasing mode.

As to claims 11, 12, 22 and 23, Okamoto et al teach at step S15 (fig. 28), it is determined whether or not there is any handwriting, when there is handwriting and the prescribed time has passed, that is, when no operation for the prescribed time after writing is detected, end of writing operation is determined (fig. 28, col. 15, lines 9-13). At step S17, handwriting erase processing is carried out (col. 15, lines 17-19).

As to claims 13 and 24, Okamoto et al teach the touch display panel 1 (fig. 1) as a pointing device.

6. As to claims 26 and 27, Okamoto et al teach a handwritten character input device associated with a method, the handwritten character input device comprising:

an operation screen unit (the touch display tablet 1, fig. 3);

a first control circuit (a front end processor 2, fig. 3);

an operation mode selecting unit (a main control portion 3 selects at least two mode such as a handwriting erase portion 6 and a handwriting display portion 5, fig. 3);

a first mode (an erase mode/the handwriting erase portion 6, fig. 3) is settable to provide a first function (an erase function, fig. 3) corresponding to the touch operation including "the handwriting erase portion 6 erases the handwriting display area" (a touch position without displaying a marker as claimed, fig. 3, col. 7, lines 15-16);

a second mode (a writing mode/the handwriting display portion 5, fig. 3) is settable to provide a second function (a writing function, fig. 3) a handwriting display area of a prescribed size (display the marker as claimed) allowing display of handwriting of in the area (col. 7, lines 3-6), if the device is in a character input and editing mode (if

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the touch operation is detected on the display screen tablet 1, col. 6, line 65), one person of ordinary skill in the art to understand that the writing mode is not effective to the erasing mode.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al in view of Lichtenstein (previously cited, US 5,428,417).

As to claims 2 and 6, Okamoto et al teach all of the claimed limitations of claims 1 and 5, except for the touch display tablet 1 is connected to a display device via a connecting module.

However, Lichtenstein teaches a touch display panel 19 (fig. 1) is connected to a display device (a projector 10, fig. 1) via a connecting module (control electronics 16, fig. 1).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to replace the touch display tablet 1 in Okamoto et al with the touch display tablet 19 (fig. 1) is connected to the display device (the projector 10, fig. 1) via a connecting module 16, in view of the teaching in the Lichtenstein's reference because this would provide new and improved

apparatus for highlighting projected graphics with a simply controlled multi graphic overlay as taught by Lichtenstein (col. 2, lines 16-19).

As to claims 3 and 7, Lichtenstein teaches a first control unit (a laptop computer, fig. 1) executes the control so that the information is exclusively displayed on any one of the display device (the projector 10, the display screen panel 19, fig. 1) and the operation screen unit (the touch display panel 19, fig. 1).

As to claims 4 and 8, Okamoto et al teach all of the claimed limitations of claims 1 and 5, except for said first display control unit controls display of a first item of information on said operation screen unit, and said second display control unit controls of a second item of information on said display device.

However, Lichtenstein teaches a related information processing system comprising a first display control unit (a control electronics 12, fig. 1, col. 10, lines 42-43) controls the touch display panel 19 (fig. 1), and a second display control unit (controllers subsystems 16 and 17, fig. 1, col. 13, lines 48-49) controls the projector 10 (fig. 1).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to replace the touch display device in Okamoto et al with the remote control touch panel assembly 22 (fig. 1, col. 6, lines 30-31) including control electronics 12 (fig. 1) controls remote touch display panel assembly 22 (fig. 1), and controllers subsystems 16 and 17 (fig. 1) controls the projector 10 (fig. 1), in view of the teaching in the Lichtenstein's reference because this would provide new and improved apparatus for highlighting projected graphics with a



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simply controlled multi graphic overlay as taught by Lichtenstein (col. 2, lines 16-19).

Moreover, where the claimed differences involve substitution of interchangeable equivalents and the reason for the selection of one equivalent for another was not to solve an existent problem such substitution has been judicially determined to have been obvious. See In re Ruff, 118 USPQ 343 (CCPA 1958).

8. Claims 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al in view of Lichtenstein, and further in view of Martin (previously cited, US 5,448,263).

As to claims 14 and 25, the combination of Okamoto et al and Lichtenstein teaches all of the claimed limitations of claims 9 and 20, except for other display devices.

However, Martin teaches a connection module (a computer 5, fig. 1) coupling to other display devices 13 and 15 (fig. 2).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify each Okamoto et al's and Lichtenstein's control electronics for coupling other display devices, in view of the teaching in the Martin's reference because this would provide every participant to input information immediately and to have such information displayed at each other site quickly and easily as taught by Martin (col. 5, lines 2-6).

***Response to Arguments***

9. Applicant's arguments filed April 28, 2005 have been fully considered but they are not persuasive. Applicant argues features in the independent claims 1, 5, 9, 16, 18, 19, 20, 26 and 27 that are newly recited. Thus, new grounds of rejection have been used. See the rejections above.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Nguyen whose telephone number is 571-272-7697. The examiner can normally be reached on MON-THU from 8:00-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

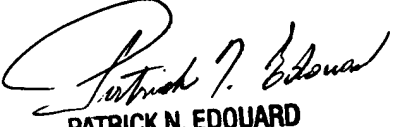
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KMN  
July 25, 2005

Kevin M. Nguyen  
Patent Examiner  
Art Unit 2674



PATRICK N. EDOUARD  
SUPERVISORY PATENT EXAMINER